

ESTTA Tracking number: **ESTTA295627**

Filing date: **07/16/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	WebMD LLC		
Entity	Limited Liability Company	Citizenship	Delaware
Address	111 Eighth Avenue Seventh Floor New York, NY 10011 UNITED STATES		

Attorney information	Michael J. Bevilacqua, Esq. Wilmer Cutler Pickering Hale and Dorr LLP 60 State Street Boston, MA 02109 UNITED STATES michael.bevilacqua@wilmerhale.com Phone:(617) 526-6448
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### Applicant Information

Application No	77632883	Publication date	06/16/2009
Opposition Filing Date	07/16/2009	Opposition Period Ends	07/16/2009
International Registration No.	NONE	International Registration Date	NONE
Applicant	Karl Storz GmbH & Co. KG Mittelstrasse 8 Tuttlingen, D-78532 GERMANY		

### Goods/Services Affected by Opposition

Class 009.

All goods and services in the class are opposed, namely: Endoscopes for technical and scientific use and structural parts therefore; illumination apparatus, namely, lights as parts of or special accessories for technical endoscopes; cameras, namely, CCD cameras for use in technical endoscopy; microscopes; adapters and cables for connecting cameras for endoscopes; computer hardware, software, and peripherals used to reproduce and record images, for use in scientific and technical endoscopy; high frequency and ultra-sonic voltage sources for non-medical endoscopes; high frequency and ultra-sonic instruments used to generate high frequency and ultra-sonic waves for use in scientific and technical endoscopy; computer hardware, software and peripherals used for training and teaching on the use of industrial endoscopes and endoscopic equipment; electronic tests and check devices for examining, testing and checking the mechanical function, optical function, magneto-electrical function, polarization, and frequency of endoscopes and endoscopic equipment; transport receptacles, namely, boxes, cases and packages designed specifically for use in storing and transporting endoscopes and endoscopic equipment; data processors; blank data media, namely, optical discs, tapes, and magnetic data carriers and computer hardware, software and peripherals for storing and/or converting and/or displaying information obtained from technical and scientific endoscopes; remote controls for endoscopes and endoscopic equipment; computer hardware for use in computer networks, computer software used for operating and networking

endoscopes and endoscopic equipment; electronic downloadable publications, namely, brochures and information sheets relating to medical instruments and apparatus
Class 010. All goods and services in the class are opposed, namely: Medical instruments and apparatus, in particular surgical instruments and apparatus, namely, surgical instruments and apparatus for open and endoscopic surgery
Class 016. All goods and services in the class are opposed, namely: Printed materials, namely, brochures and information sheets in the field of medical technology

## Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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## Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	1978357	Application Date	06/26/1995
Registration Date	06/04/1996	Foreign Priority Date	NONE
Word Mark	MED SCAPE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1995/04/17 First Use In Commerce: 1995/04/17 providing information to assist healthcare providers in improving delivery of patient care in the areas of topical information in the fields of infectious diseases, AIDS, surgery, urology, family medicine, internal medicine, primary care medicine, pediatrics, psychiatry, orthopedics, respiratory diseases, cardiology, pharmacology, nursing, health economics; providing on-line questions for interactive self-assessment, and continuing general and specialized medical education in the above-identified fields, all through the means of a computer network		

Attachments	MEDSCAPE NOP.PDF ( 5 pages )(237771 bytes )
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## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/barbara a. barakat/
Name	Barbara A. Barakat, Esq.
Date	07/16/2009

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Application Serial No. 77/632883

Published in the Official Gazette at TM 208 on June 16, 2009

WebMD LLC,

Opposer

v.

Karl Storz GmbH & Co. Kg.,

Applicant

Opposition No.

BOX TTAB/FEE  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

NOTICE OF OPPOSITION

WebMD LLC, a limited liability company organized and existing under the laws of Delaware, located and doing business at 111 Eighth Avenue, Seventh Floor, New York, New York 10011, believes that it will be damaged by the registration of the trademark "MEDSCAPE" as shown in Application Serial No. 77/632883, filed December 15, 2008, by Karl Storz GmbH & Co. Kg. (hereinafter "Applicant"), and hereby opposes the same.

As grounds for opposition, it is alleged that:

1. Applicant seeks registration on the Principal Register of the trademark "MEDSCAPE" for use in connection with endoscopes for technical and scientific use and structural parts therefore; illumination apparatus, namely, lights as parts of or special accessories

for technical endoscopes; cameras, namely, CCD cameras for use in technical endoscopy; microscopes; adapters and cables for connecting cameras for endoscopes; computer hardware, software, and peripherals used to reproduce and record images, for use in scientific and technical endoscopy; high frequency and ultra-sonic voltage sources for non-medical endoscopes; high frequency and ultra-sonic instruments used to generate high frequency and ultra-sonic waves for use in scientific and technical endoscopy; computer hardware, software and peripherals used for training and teaching on the use of industrial endoscopes and endoscopic equipment; electronic tests and check devices for examining, testing and checking the mechanical function, optical function, magneto-electrical function, polarization, and frequency of endoscopes and endoscopic equipment; transport receptacles, namely, boxes, cases and packages designed specifically for use in storing and transporting endoscopes and endoscopic equipment; data processors; blank data media, namely, optical discs, tapes, and magnetic data carriers and computer hardware, software and peripherals for storing and/or converting and/or displaying information obtained from technical and scientific endoscopes; remote controls for endoscopes and endoscopic equipment; computer hardware for use in computer networks, computer software used for operating and networking endoscopes and endoscopic equipment; electronic downloadable publications, namely, brochures and information sheets relating to medical instruments and apparatus, in class 9, medical instruments and apparatus, in particular surgical instruments and apparatus, namely, surgical instruments and apparatus for open and endoscopic surgery in class 10 and printed materials, namely, brochures and information sheets in the field of medical technology in class 16, as evidenced by the publication of said trademark in the June 16, 2009 issue of the Official Gazette.

2. Opposer is now, and has been for some time, engaged in providing information, education, journals, databases, training and Internet based on-line forums related to all aspects of health care, including medical conditions, diseases and disorders, medical treatments, wellness and nutrition, health risk assessments, health care provider, physician and hospital rating and referrals, and insurance.

3 Opposer and Opposer's predecessor in interest, (hereinafter "Opposer") adopted the mark "MED SCAPE" in connection with health care related services, that is, providing information to assist healthcare providers in improving delivery of patient care in the areas of topical information in the fields of infectious diseases, AIDS, surgery, urology, family medicine, internal medicine, primary care medicine, pediatrics, psychiatry, orthopedics, respiratory diseases, cardiology, pharmacology, nursing, health economics; providing on-line questions for interactive self-assessment, and continuing general and specialized medical education in the above-identified fields, all through the means of a computer network, at least as early as April 17, 1995, and has been using the mark in connection with those services ever since. Such use has been valid and continuous since the date of first use and has not been abandoned.

4. Opposer is the owner of United States registration No. 1978357 for the mark MED SCAPE in connection with the services identified in paragraph 3.

5. Opposer's mark "MED SCAPE" is symbolic of the extensive goodwill and recognition built up by Opposer through continuous use of said mark over a substantial period of time.

6. Opposer has expended considerable effort and expense in promoting its mark "MED SCAPE" and the services provided in connection with such mark, with the result that the

purchasing public has come to know, rely upon, and recognize the services of Opposer by such mark. Opposer has exceedingly valuable goodwill established in its mark.

7. Application Serial No. 77/632883 for registration of the mark "MEDSCAPE" was filed on December 15, 2008, based upon Applicant's corresponding German registration dated August 19, 2008 and Applicant's bona fide intent to use said mark. Thus, Opposer actually began using its MED SCAPE mark at least 13 years prior to the effective filing date of Applicant's application. Opposer's registration for the mark "MED SCAPE" issued more 12 years prior to the effective filing date of Applicant's application.

8. Opposer's mark "MED SCAPE" and Applicant's mark "MEDSCAPE" are virtually identical in appearance and identical in sound.

9. The services which are identified in Opposer's registration for its mark are closely related to the goods identified in the Applicant's application to register "MEDSCAPE," and on information and belief, will be marketed through the same or similar channels of trade or to the same or similar class of consumers.

10. By reason of Opposer's extensive use of the "MED SCAPE" mark, the public will believe that the Applicant's use of its mark "MEDSCAPE" is sponsored or approved by Opposer and that the quality of the services bearing the Applicant's mark has been approved and/or maintained by Opposer.

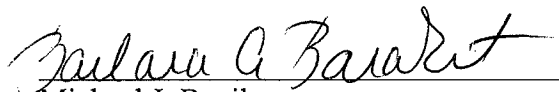
11. In view of these similarities, Applicant's use of the mark "MEDSCAPE" is likely to cause confusion, mistake, or deception with respect to Opposer's mark "MED SCAPE" and to damage the goodwill represented and symbolized by the mark.

12. Based on the foregoing, Applicant's registration of the mark "MEDSCAPE" on the Principal Register of the United States Patent and Trademark Office would clearly cause injury and damage to the Opposer.

WHEREFORE, Opposer prays that this opposition be sustained and that registration of Applicant's mark "MEDSCAPE" as shown in Application Serial No. 77/632883 be refused.

Respectfully submitted,

WEBMD LLC



Michael J. Bevilacqua

Reg. No. 31,091

Barbara A. Barakat

Reg. No. 32,190


Attorneys for Opposer

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60 State Street  
Boston, Massachusetts 02109  
(617) 526-6154  
July 16, 2009

#### CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Notice of Opposition was served by first-class mail, postage-prepaid, this 16<sup>th</sup> day of July, 2009, upon:

Wesley W. Whitmyer, Jr., Esq.  
St. Onge Steward Johnston & Reens LLC  
986 Bedford Street  
Stamford, CT 06905-5619



Barbara A. Barakat